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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,806	06/11/2001	David A. Boeke	J&J-2025	3753
27777	7590	05/21/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			MCCLELLAN, JAMES S	
		ART UNIT	PAPER NUMBER	
		3627		

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/878,806	Applicant(s) BOEKE, DAVID A.
	Examiner	Art Unit
	James S McClellan	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 17 March 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 9-16 and 18-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 9-16 and 18-23 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

### ***Amendment***

1. Applicant's submittal of an amendment was entered on March 17, 2004 wherein:
  - claims 9-16 and 18-23 are pending;
  - claims 1-8 and 17 have been canceled; and
  - claims 9, 19, and 20 have been amended.

### ***Claim Objections***

2. Claim 18 is objected to because of the following informalities: claim 18 currently depends from canceled claim 17. For purposes of examination, it was assumed that claim 18 depends from claim 9. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 10, 12, 14-16, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,870,717 (hereinafter "Wiecha") in view of U.S. Patent No. 5,970,474 (hereinafter "LeRoy").

Regarding **claim 9**, Wiecha discloses a method for cooperative ordering of medical products over a network, comprising: providing a database (24) comprising information for purchasing a plurality of products; transmitting information for at least one product to a first client from said database of products (see column 3, lines 10-28); receiving from said first client a request to order said at least one product (see column 3, lines 29-37); storing said request to order said at least one product (see column 3, lines 29-37); and receiving from a second client an authorization to purchase said at least one product (see column 3, lines 29-37); **[claim 10]** the medical products comprise surgical procedure products; **[claim 12]** the network comprises the Internet (see column 7, lines 35-39); **[claim 14]** said product information comprises price information and wherein said price information is dependent on a customer account provided by one of said first and second client (see column 3, lines 13-16); and **[claim 19]** a computer-readable medium bearing instructions for carrying out the method of claim 9 (it is inherent that instructions to execute Wiecha's system are stored on a computer-readable medium).

Regarding **claim 20**, Wiecha discloses a system for cooperative ordering of medical products as described above in for method claim 1.

Regarding **claims 9 and 20**, Wiecha fails to expressly disclose transmitting information to a third client indicative of the request for order by the first client, wherein the user at the third client may submit an order based on the order by the first client and may add a product to the third client's request.

LeRoy discloses a registry system for shoppers to purchase items selected by another user (see column 5, lines 41-51), wherein it is inherent that the shoppers to add additional items.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha with registry shopping feature LeRoy, because a registry allows a second customer to purchase a product previously selected by a first customer, when the second customer is unsure what products to order.

5. Claims 11, 13, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha in view of LeRoy as applied to claims 9, 10, 12, 14-16, 20, and 22 above, and further in view of U.S. Patent No. 5,991,728 (hereinafter "DeBusk").

Regarding **claims 11, 18, and 21**, Wiecha in combination with LeRoy fail to expressly disclose an order comprising at least two products, wherein said two products are both used in a single medical operation.

DeBusk teaches the use of medical product ordering system that discloses an order comprising at least two products, wherein said two products are both used in a single medical operation (see column 7, lines 21-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha/LeRoy with the bundling of medical products used in the same medical procedure as taught by DeBusk, because ordering in bundles will help to ensure that all medical products for a specific medical procedure are ordered together and are available to the health care professional at the time of the medical procedure. In contrast, ordering medical products individually would have a larger chance of the overall order containing an ordering error.

Regarding **claim 13**, Wiecha in combination with LeRoy fail to expressly disclose transmitting information for a second product wherein said second product is a substitute for said first product.

DeBusk teaches the use of substituting products (see column 10, lines 18-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha/LeRoy with product substitution as taught by DeBusk, because providing a substitute product allows an order to be filled when the originally selected product is unavailable and thus reduces the time to reorder.

6. Claims 12, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha in view of LeRoy as applied to claims 9, 10, 12, 14-16, 20, and 22 above, and further in view of Official Notice.

As alternative rejection, if it is held that Wiecha in combination with LeRoy fail to inherently disclose communication over the Internet utilizing web pages, then the Examiner relies on Official Notice that it was old and well known at the time the invention was made to communicate information over the Internet utilizing web pages.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha with Internet communication as was well known in the art, because utilizing the Internet allows global communication, wherein increasing the potential for suppliers to contact customers.

U.S. Patent Application No. US 2002/0065758 A1 (hereinafter "Henley") is relied upon as evidence of the use of Internet web pages as a form of global communication.

***Response to Arguments***

7. Applicant's arguments filed March 17, 2004 have been fully considered but they are not persuasive.

On page 5, second and third paragraphs, Applicant traverses the objection of claim 19. As indicated by Applicant, claim 19 is directed to an apparatus. The objection is withdrawn.

On page 5, fourth and fifth paragraphs, Applicant argues that Wiecha fails to disclose amended claims 9 and 20. Applicant's argument is moot in view of the new grounds of rejection necessitated by Applicant's amendment.

On page 5, final two paragraphs, Applicant fails to adequately traverse the Examiner's assertion of Official Notice. As set forth in MPEP 2144.03 C, to adequately traverse a finding of Official Notice, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered common knowledge. Since Applicant's traversal of the Examiner's assertion of Official Notice is inadequate, the common knowledge statement is taken to be admitted prior art (see MPEP 2144.03). Since this application is made final, the Examiner voluntarily cited a reference (Henley) as factual evidence to support the Examiner's assertion of Official Notice.

On page 6, Applicant argues that the remaining dependent claims are allowable because they depend from claims 9 and 20. As indicated above, Applicant's arguments are moot in view of the new grounds of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

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(703) 872-9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

*James S. McClellan*  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
May 17, 2004